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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,907	01/28/2002	Thibaut Montanari	ATOCM-246	1484
23599	7590	05/05/2004		
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER WOODWARD, ANA LUCRECIA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/055,907	Applicant(s) MONTANARI ET AL.	
	Examiner Ana L. Woodward	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-22, 25-28, 30-50 and 55-71 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8, 22, 27, 31, 32, 34, 58 and 60-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-13, 15-21, 25, 26, 28, 30, 33, 35-50, 55-57, 59 and 63-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 4, 8, 22, 27, 31, 32, 34, 58 and 60-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper filed October 23, 2003.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-3, 5-7, 9-13, 15-21, 25, 26, 28, 30, 33, 35-50, 55-57, 59 and 63-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide express support for the lower limit "35%" now governing the amorphous polyamide (B). Since no express support can be found for said new limitation, such is deemed new matter.

3. Claims 1-3, 5-7, 9-13, 15-21, 25, 26, 28, 30, 33, 35-50, 55-57, 59 and 63-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the metes and bounds of the claims are rendered indefinite by the various overlaps in scope existing among the recited components. For instance, each of the generically (C2), (D) and (M) components not only read on each other and but they also read on each of the

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polyamides (A) and (B). Accordingly, it is unclear as to how many different components are required by the claims.

In claim 1, line 9, did applicants intend "(B3)" as opposed to (B)?

In claim 28, the spelling of "oenantholactum" is queried.

In claims 33, 35, 36, 39 and 47, the term "supple" is indefinite as to scope and meaning.

In claim 39, the Markush group format is improperly recited. As presently recited, it appears that all the recited modifiers are required at the same time.

In claim 39, the term "functionalized" is indefinite as to scope and meaning.

In claim 46, did applicants intend "(D)" as opposed to (B)?

In claims 63 and 71, "a" is queried.

In claim 67, the PEBA is not further limiting.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-3, 13, 15-21, 25, 26, 28, 30, 33, 37, 41-44, 46-50, 63, 65, 68 and 71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,886,087 (Dalla Torre).

In example 4, patentees disclose a composition comprising 50 weight % of an amorphous polyamide made up from bis-(3-methyl4-amino-cyclohexyl) methane and dodecanedioic acid and 50 weight% of PA 12.

It is maintained that the disclosed example meets the requirements of applicants' claims, as presently recited, both in terms of the types of materials added and their contents. This is because the amount of the amorphous polyamide over 35% (or over the upper limit of claims 13, 15-21, 63 or 71) would be considered to fulfill the requirements for any of the generically recited components (C2), (D) or (M). In this regard, it is again noted that each of the generically (C2), (D) and (M) components not only read on each other and but they also read on each of the polyamides (A) and (B). Accordingly, the above-rejected claims are being interpreted as containing only two polyamides.

***Claim Rejections - 35 USC § 103***

7. Claims 5-7, 9-12, 35, 36, 38-40, 45, 55-57, 59, 64, 66, 67, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,886,087 (Dalla Torre) in view of U.S. 4,416,172 (Blondel et al), U.S. 5,288,799 (Schmid et al) and U.S. 4,977,213 (Giroud-Abel et al).

With respect to the requirement that the amorphous polyamide be derived from isophoronediamine (e.g., claims 5, 64), it is maintained that such is generically encompassed and rendered obvious by Dalla Torre's generic disclosure of cycloaliphatic diamines to one having ordinary skill in the art. In this regard, further noted is Blondel et al's specific disclosure of

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isophoronediamine as a conventional cycloaliphatic diamines in the production of analogous amorphous polyamides (column 4, line 34).

With respect to claims 9, 55, 56 and 69, it is noted that PA 11 can be advantageously used by Dalla Torre in lieu of the exemplified PA 12 (column 3, line 9). Said PA 11 would simultaneously read on component A and C.

Dalla Torre differs in essence from applicants' claims 6, 7, 12, 35, 36, 39, 40, 57, 59, 66 and 67 in not expressly exemplifying applicants' preferred materials defining components C) or M). It is noted, however, that Dalla Torre states that optional additives, such as, impact strength modifiers can be added to his invention (column 3, line 20). In this regard, attention is directed to the teachings of Schmid et al and Giroud-Abel et al wherein it is taught that functionalized polyolefins and polyesteramides (meeting applicants' preferred C and M materials) are known impact modifiers for polyamide compositions. Accordingly, it would have been obvious to one having ordinary skill in the art to have used a conventional impact modifier, as taught by the secondary references, as the impact strength modifier in Dalla Torre's compositions.

As to the presence of a catalyst (claims 10, 11, etc), although not expressly disclosed by Dalla Torre, it is maintained that in light of Blondel et al's teachings, it would have been obvious to one having ordinary skill in the art to have added an amidification or trans-amidification catalyst, such as phosphoric acid, for its expected additive effect, to Dalla Torre's polyamide composition with the reasonable expectation of success. It is reasonably believed that said polyamide-containing composition would meet the requirements of the applicants' "catalysed" polyamide since it would necessarily contain the catalyst "during the subsequent steps of the preparation of the compositions". It is noted that in the present invention, "the catalyst may be

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added to the polyamide (D) **after it has been prepared**". Accordingly, no patentability can be seen in the presently claimed subject matter.

### ***Double Patenting***

8. Claims 1-3, 5-7, 9-13, 15-21, 25, 26, 28, 30, 33, 35-50, 55-57, 59 and 63-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/240,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications contain overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Response to Arguments***

10. Applicant's arguments filed April 5, 2004 have been fully considered but they are not persuasive.

It is maintained that the example disclosed by Dalla Torre meets the requirements of applicants' claims, as presently recited, both in terms of the types of materials added and their

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contents. This is because the amount of the amorphous polyamide over 35% (or over the upper limit of claims 13, 15-21, 63 or 71) would be considered to fulfill the requirements for any of the generically recited components (C2), (D) or (M). In this regard, it is again noted that each of the generically (C2), (D) and (M) components not only read on each other and but they also read on each of the polyamides (A) and (B). Accordingly, the above-rejected claims are being interpreted as containing only two polyamides.

***Priority***

11. The indication that the present application is a child application to SN 09/174,266, 08/662,514 and 08/277,410 all directed to Computer Scanners, appears to be incorrect and is queried.

***Conclusion***

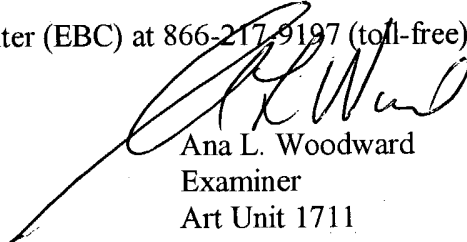
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward  
Examiner  
Art Unit 1711

AW